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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,095	11/22/2000	Aaron I. Vinik	05216.00001	5818

22907 7590 12/31/2003

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/717,095

Applicant(s)

VINIK ET AL.

Examiner

Hope A. Robinson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 112, first paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-24.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's response to the Office Action mailed April 21, 2003 on November 26, 2003 is acknowledged.

#### *Claim Disposition*

2. Claims 12, 17 and 24 have been amended. Claims 1-24 are pending and under examination.

3. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,840,531, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP 1404, 1442.01 and 1442.04.

4. Applicant's arguments filed November 26, 2003 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 112, first paragraph has been withdrawn.

The rejection under 35 U.S.C. 103, NonStatutory Double Patenting, has been maintained.

5. Claims 1-24 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 09/659,379 for the reasons of record.

6. Applicant's arguments filed on November 26, 2003 have been fully considered. It is noted that applicant has amended claims as suggested by the office to obviate the rejections under 35 U.S.C. 112, first paragraph but have not incorporated the proposed language to obviate the grounds of rejection under 35 U.S.C. 103 (Obvious-type Double Patenting). Therefore, rejections under 35 U.S.C. 103, Obvious-type Double Patenting remain. Pages 5-8 of the response merely state the facts presented in case laws and statutes pertaining to double patenting which have been considered but does not warrant any remarks from the examiner. The arguments presented on pages 9-17 will be addressed in this office action.

On page 9 of the response applicant contends that copending application 09/659,379 independent claim 1 recites "a first nucleotide sequence encoding amino acid residues 27-175 as shown in SEQ ID NO:6 and that this excludes residues 1-26" (see also claims 2-12, 16, 19 and 20; the method claim 13-17 also has this exclusion). The issue here remains that the claims in the copending application recite the open language "comprising" in association with the recitation of "residues 27-175", thus, residues 1-26 are not really excluded as asserted by applicant. The recited sequence in the copending application has one residue difference with the sequence set forth in the instant application. The present application is directed to an isolated DNA molecule which encodes an INGAP protein set forth in SEQ ID NO: 2 which is identical to SEQ ID NO: 6 of the copending application with the exception of one residue (SEQ ID NO: 6 has an additional Methionine in the beginning of the sequence) and as open language is present the sequences in the applications are obvious. The same situation is present in claims 13-17. Applicant cites the specification of the copending application in an attempt to obviate this ground of rejection over claim 21. Applicant is reminded that the limitation of the specification cannot be read into the claims. A comparison of one claim set over another is the process in the double patenting rejection, not the disclosures of the two applications. The same argument is presented

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for copending claims 23, 29, 45, 22, 24-28, 30-44, 46 and 48-49 , which has already been addressed.

At pages 10-17, applicant provides a discussion that involves a break down of *Graham v. John Deere Co.* and subheadings entitled (a) differences between the prior art and claims; (b) level of skill in the art; (c) failure to establish a prima facie case of obviousness and (d) erroneous factual underpinnings to PTO's Obviousness Assertion raised. Applicant's statements have been considered. Again the argument is made that residues 1-26 of SEQ ID NO:2 in the instant application is excluded from SEQ ID NO: 6 of the copending application, which is not factual as the claim recites open language which would include those residues. Regarding the argument presented about claims directed to probes, primers and anti-sense constructs, the rejection of record sets forth that the two applications although differ in scope are obvious variations of each other, for example, a probe is not specific as such can be obtained from any polynucleotide.

Applicant on page 14 states that the rejection is based on a number of misapprehensions reflected in misstatements of fact in the office action. Applicant is reminded that a terminal disclaimer was filed in response to the above rejection now stated to be erroneous, however, the terminal disclaimers were improper. In addition, the office drafted claims, which would not warrant the filing of terminal disclaimers and are deemed allowable which applicant has refused. In view of the foregoing, applicant's statements are not persuasive and thus the rejection remains.

### ***Conclusion***

7. No claims are allowable.


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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:30 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2932.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope A. Robinson, MS 

Patent Examiner



CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
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